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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/620,513	07/16/2003	Peter Zhu	ASP-27DIV	8485
27777	7590	08/09/2005	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			KORNAKOV, MICHAEL	
			ART UNIT	PAPER NUMBER
			1746	

DATE MAILED: 08/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/620,513

Applicant(s)

ZHU ET AL.

Examiner

Michael Kornakov

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>08/27/2003</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 12, 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With regard to claim 12, it is unclear if whether the kit contains solvent or it is only required and is being outside the claimed kit;

With regard to claim 13, it uses the improper Markush recitation, and thus makes it unclear if the hydrogen catalyst is an alternative or in addition to the recited reducing agents.

3. Claims 10-17 are pending in the Application.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 10, 12, 13, 14 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Redlich et al (U.S. 3,892,523).

Redlich discloses treatment of leather, which has been discolored by aldehyde tanning and is bleached by treatment of the tanned leather with sodium Borohydride (**NaBH₄**) (Abstract). With regard to the nature of an aldehyde stain, which is an imine formed by a reaction of aldehyde with amine that is present in the subject to be cleaned, Redlich teaches that while tanning with aldehyde the discolored stains appear. Since the calfskin leather used by Redlich (col. 2, Example 1, line 12), comprises proteins and amino acids, that have both carboxyl and aminogroups, the reaction of aldehyde with amino group of leather inherently produces imines (Shiff bases) as claimed in the instant claim 17. The treatment involves using aqueous solution (col.2, line 2), thus providing for water as a solvent. Redlich further teaches that the application is done by dipping, spraying, padding or the like, thus inherently providing for means to accomplish such spraying, dipping or padding. (col.2, line 3). Therefore, the "kit" of the instant claims reads on Redlich's spraying padding or dipping. In interpreting the "kit", a case, which addresses the issue of "kit" claims is *In re Venezia*, 189 USPQ 149 (CCPA 1976). In a claim that was directed to a kit of component parts capable of being assembled, the Court held that limitations such as "members adapted to be positioned" and "portions . . . being resiliently dilatable whereby said housing may be slidably positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly. *In re Venezia*, 530 F.2d 956, 189 USPQ 149 (CCPA 1976). The plain meaning of the term simply would not allow a reasonable interpretation that it encompasses anything other than what a reasonable person would ordinarily understand to be a kit (see also MPEP 2173.05(h)). It is further noted that the word "kit"

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does not have to appear in the prior art reference. However, the presence of a reducing agent, such as a sodium borohydride and means for spraying, dipping or padding is understood as a kit.

With regard to the instructions as recited in the instant claim 10, Applicants are directed to MPEP 2112.01 (III) that states "where the only difference between a prior art product and a claimed product is printed matter that is not functionally related to the product, ***the content of the printed matter*** will not distinguish the claimed product from the prior art. In re Ngai, F.3d, 2004, WL 1068957. See also In re Gulack, 703 F.2d 1381, 1385-86, 217 USPQ 401, 404 (Fed. Cir. 1983) ("Where the printed matter is not functionally related to the substrate, the printed matter will not distinguish the invention from the prior art in terms of patentability).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).
8. Claims 11, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Redlich in view of U.S. 5,885,954 to Chicarielli.

Redlich discloses the invention as claimed, and the basis of the rejection is described above.

Redlich does not specifically disclose the presence of container, as per claim 11, and that the container is a spray bottle, as per claim 15.

However, Redlich provides a clear motivation and suggestion of having such attributes by stating that sodium borohydride can be applied to the calfskin in any conventional manner (col.2, line 1), such as dipping, spraying padding or the like. Such application necessarily requires the use of suitable means.

The use of spray bottles to contain and apply stain removers is well known and widely used in the art. Thus US 5,885,954 discloses a kit of stain remover for textured walls and ceilings. To apply the stain remover formulation solution, it is convenient to

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use a **bottle sprayer** that has been filled with the correct proportion of water and powdered stain remover formulation. The powdered stain remover formulation is first emptied into the **spray bottle** and then mixed with water to yield a fairly homogenous solution.

Therefore, it would have been obvious to those skilled in the art at the time the invention was made to use a spray bottle of US'954 for the suggested spraying application of Redlich, and thus to arrive at the instant claims 11 and 15.

9. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Redlich in view of Akbarian (U.S. 20050049163).

Redlich discloses the claimed invention, but does not specify the dropper, as the means for delivering the reducing agent. Akbarian teaches a cleaning kit comprising one or more portions of a predetermined dimension of absorbent stain removal medium, the kit 100 also comprises a **plastic bottle** 120 with a sealing cap 122 over a **dropper** or other type distal tip 124 to controllably dispense a pre-treatment stain formula 126 for pre-treating spots prior to cleaning. [0030].


Thus, motivated by the suggestion of Redlich to apply the aldehyde stain remover by any conventional manner (col.2, line1), it will be with the skill in the art to utilize the bottle with dropper, as suggested by Akbarian (for solving the same problem) in the kit of Redlich and thus to arrive at the instant claim 16.

It is noted here that the Application 09/321,964 does not contain the "dropper" subject matter, and therefore, the priority for this subject matter is not given as 05/28/199.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Kornakov whose telephone number is (571) 272-1303. The examiner can normally be reached on 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Barr can be reached on (571) 272-1414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Michael Kornakov
Primary Examiner
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08/05/2005